



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,515	02/11/2004	John P. Maguire	52418.830004.US0	4719
26582	7590	02/14/2008		
HOLLAND & HART, LLP P.O BOX 8749 DENVER, CO 80201			EXAMINER PAINTER, BRANON C	
			ART UNIT	PAPER NUMBER
			3633	
			MAIL DATE	DELIVERY MODE
			02/14/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/782,515	Applicant(s) MAGUIRE ET AL.	
	Examiner BRANON C. PAINTER	Art Unit 3633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 20 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-19 and 25-27 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 3,4,8,10,11 and 13-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

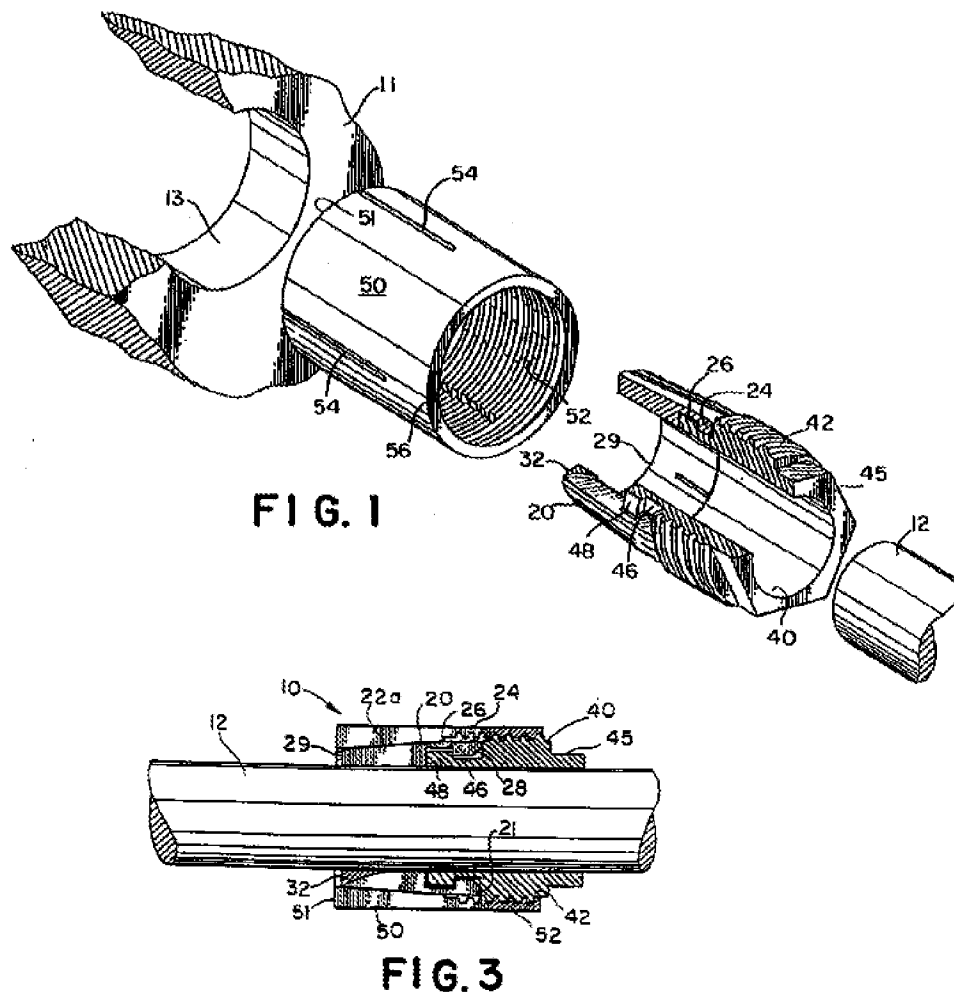
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 9, 12, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Geib (U.S. Patent No. 5,695,297).
3. Regarding claim 1, Geib discloses a mounting device having all of the applicant's claimed structure, including:
 - a. A body defining a cavity ("outer sleeve" 50, Fig. 1,3), the body having top (right edge of "outer sleeve" 50 as seen in Fig. 1) and bottom ends ("forward end" 51, Fig. 1,3).
 - b. A wedge portion that connects to the body using threads and encircles a support member received in the cavity ("locking nut" 40 encircling "shaft" 12, Fig. 1,3).
 - c. A compression ring disposed in the cavity that expands and contracts in response to the movement of the wedge portion relative to the body ("inner sleeve" 20, Fig. 1,3; "nut 40 is interlocked with the inner sleeve 20 so as to permit the tapered external surface of the inner sleeve to slide up and down the inclined internal surface of the outer sleeve 50 when the nut is rotated. Sliding up toward the forward end 51, the tapered internal surface of the

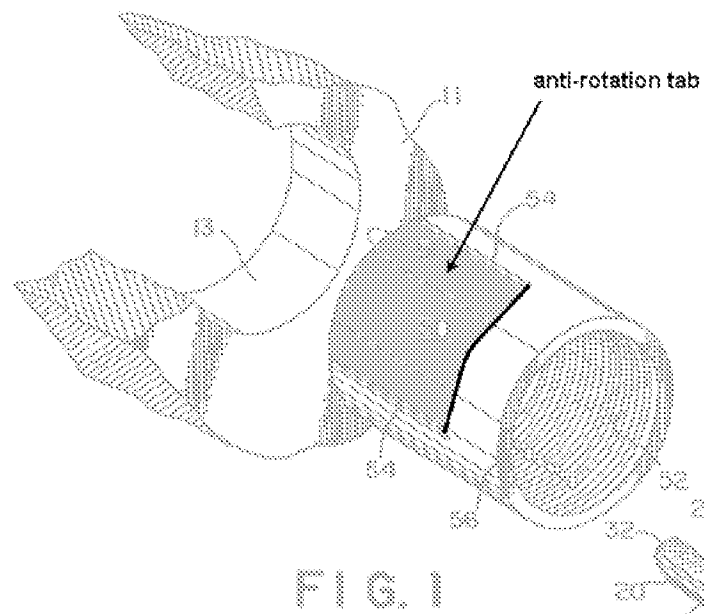
Art Unit: 3633

outer sleeve locks the inner sleeve 20 against the shaft 12 and the outer sleeve 50 against the bore 13 of the element 11. Sliding down the surface unlocks the mounting device 10," column 4, lines 12-20).



Reproduced from Geib

4. Regarding claim 9, Geib discloses an anti-rotation tab connected to the body ("anti-rotation tab," amended Fig. 1). The examiner notes that upon insertion of the wedge and compression ring, the anti-rotation tab deflects outward to prevent slippage (or unwanted rotation) between the body and a machine element 11.



Reproduced from Geib

5. Regarding claim 12, Geib discloses an anti-rotation tab connected to the rest of the body approximately midway between the top and bottom ends of the body ("anti-rotation tab," amended Fig. 1).
6. Regarding claim 21, Geib discloses a wedge portion disposed in the cavity ("locking nut" 40, Fig. 1,3).
7. Claims 1 and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Geib (U.S. Patent No. 5,695,297).
8. Regarding claim 1, Geib discloses a mounting device having all of the applicant's claimed structure, including:
 - a. A body defining a cavity ("outer sleeve" 50, Fig. 1,3), the body having top ("forward end" 51, Fig. 1,3) and bottom ends (right edge of "outer sleeve" 50 as seen in Fig. 1).

- b. A wedge portion that connects to the body using threads and encircles a support member received in the cavity ("locking nut" 40 encircling "shaft" 12, Fig. 1,3).
 - c. A compression ring disposed in the cavity that expands and contracts in response to the movement of the wedge portion relative to the body ("inner sleeve" 20, Fig. 1,3; "nut 40 is interlocked with the inner sleeve 20 so as to permit the tapered external surface of the inner sleeve to slide up and down the inclined internal surface of the outer sleeve 50 when the nut is rotated. Sliding up toward the forward end 51, the tapered internal surface of the outer sleeve locks the inner sleeve 20 against the shaft 12 and the outer sleeve 50 against the bore 13 of the element 11. Sliding down the surface unlocks the mounting device 10," column 4, lines 12-20).
9. Regarding claim 22, Geib discloses a body with a tapered interior wall proximate the top end (inner wall of "outer sleeve" 50 nearest "forward end" 51, Fig. 3) and a compression ring in contact with the tapered interior wall ("inner sleeve" 20, Fig. 1,3).
10. Regarding claim 23, Geib discloses a compression ring moving relative the longitudinal axis of the cavity in response to movement of the wedge ("inner sleeve" 20, Fig. 1,3).
11. Regarding claim 24, Geib discloses a elongated, continuous compression ring having first and second ends, encircling the support member, and contacting the support member to connect it to the anchor ("inner sleeve" 20, Fig. 1,3).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 2 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geib (U.S. Patent No. 5,695,297).

15. Regarding claim 2:

- a. Geib discloses a mounting device as set forth above, and further teaches a member made from steel ("the inner sleeve is made from 1215 steel," column 4, lines 62-63).
- b. Geib does not expressly disclose that the wedge and body are formed from stainless steel.
- c. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the wedge and body of Geib by making them

from stainless steel, in order to produce members with higher resistance to rust and corrosion.

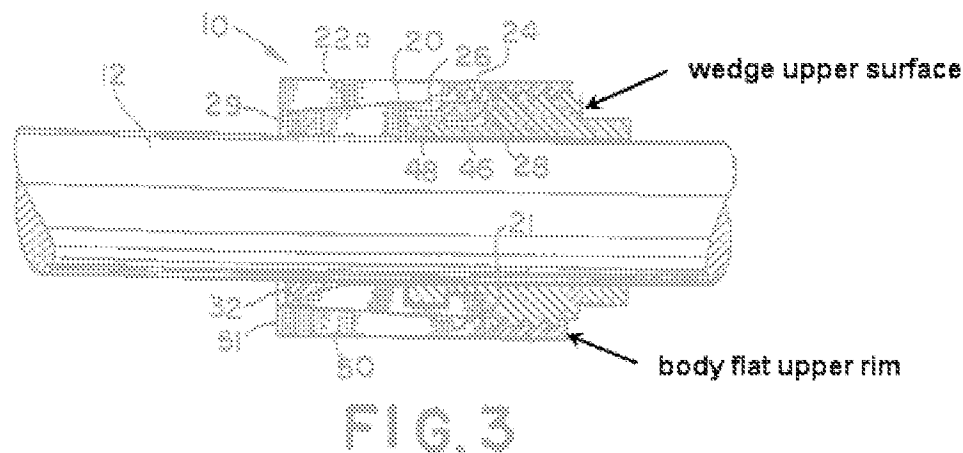
- d. Geib discloses the claimed invention except for a wedge and body made from stainless steel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make these pieces from stainless steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

16. Regarding claim 5:

- a. Geib discloses a mounting device as set forth above, and further teaches a wedge with a substantially flat upper surface ("wedge upper surface," amended Fig. 3) and a body with a substantially flat upper rim ("body flat upper rim," amended Fig. 3).
- b. Geib does not expressly disclose that the two flat surfaces are substantially flush.
- c. It would be obvious to one of ordinary skill in the art that if one continued to screw the wedge member further into the body, the two flat surfaces will reach a point where they are substantially flush.
- d. The examiner notes that the limitation "are positioned to be substantially flush with a ground surface with a ground surface in which the anchor may be positioned" does not positively claim a ground surface, only that the flat

Art Unit: 3633

surfaces of the wedge and body are flush with a ground surface which they may or may not be positioned in. The mounting device of Geib is capable of being inserted into a ground surface such that the two flat surfaces discussed above are flush with the ground surface, and therefore meets the claim limitations.



Reproduced from Geib

17. Regarding claim 6:

- a. Geib discloses a mounting device as set forth above.
- b. Geib does not expressly disclose that the cavity has a diameter of 1.4-1.6 inches.
- c. The examiner further notes that it would have been an obvious matter of design choice to modify the cavity of Geib by giving it a diameter of 1.4-1.6 inches, since applicant has not disclosed that this diameter range solves any stated problem or is for any particular purpose and it appears that any cavity diameter that allows for threaded engagement with the wedge portion

Art Unit: 3633

resulting in a clamping of the compression ring onto the support member would perform equally well.

- d. The examiner notes that where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device is not patentably distinct from the prior art device. *MPEP 2144.04*.
- e. Geib discloses the claimed invention except for a cavity whose diameter is 1.4-1.6 inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to give the cavity a diameter of 1.4-1.6 inches, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *MPEP 2144.05*.

Response to Arguments

18. Applicant's arguments, see Applicant's Remarks, filed 11/09/07, with respect to the rejection(s) of claim(s) 1-19 under 35 U.S.C. 102 or 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Geib (U.S. Patent No. 5,695,297).

Allowable Subject Matter

Art Unit: 3633

19. Claims 3-4, 8, 10-11, and 13-15 are objected to as being dependent upon a rejected base claim, but would be allowable over the prior art of record if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
20. Claims 16-19 and 25-27 are allowable over the prior art of record.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANON C. PAINTER whose telephone number is (571)270-3110. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3633

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. C. P./
Examiner, Art Unit 3633
02/06/08

/Brian E. Glessner/
Supervisory Patent Examiner, Art Unit 3633